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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,007	12/03/2001	Bruno Lokietek	2-1032-181	2153
7590	11/26/2003			
Martin G Mullen Henderson & Sturm Suite 1020 1301 Pennsylvania Avenue NW Washington, DC 20004-1707				EXAMINER HALPERN, MARK
				ART UNIT 1731
				PAPER NUMBER DATE MAILED: 11/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,007	LOKITEK ET AL.	
	Examiner	Art Unit	
	Mark Halpern	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 October 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 49-65 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 49-65 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____ .

DETAILED ACTION

- 1) Acknowledgement is made of RCE approved on 10/1/2003. Acknowledgement is made of Amendment received 10/28/2003. Applicants cancel claims 1-48, and offer new claims 49-65, for consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 2) Claims 49-65, are rejected under 35 U.S.C. 102(b) as being anticipated by Gosset (5,129,989).

Claims 49-52: Gosset discloses a process for manufacturing paper (Abstract). A composition of cationic starches (col. 4, lines 23-64) and starch sulfocarboxyls, such as, 3-chloro-2-sulfo-propionic acid, is added in the process. The addition of said starches can be performed at several points in the process, for example, at the wet end, which reads on the claimed internal treatment (col. 3, lines 18-25). The fibrous composition simultaneously comprises said cationic starches and said starch sulfocarboxyls. The total amount of cationic and sulfonated starch added to the paper product is from 0.4 to 10 %, expressed as a percentage of dry starch with respect to the dry fibrous

composition (col. 3, lines 34-44). Also disclosed is addition of compound sodium monochloracetate (col. 5, lines 4-23).

Claims 53-55: a weight ratio of cationic to sulfonated starches of 10/1 to 1/10 is disclosed (col. 3, line 64 to col. 4, line 2).

Claims 56-57: the composition is a solid mixture in the form of a powder (col. 3, line 62).

Claims 58-59: the composition is an aqueous suspension (col. 3, line 60-62).

Claims 60-61: the composition is introduced in the form of aqueous size (col. 3, lines 45-49).

Claim 62: starches not directly soluble in water are disclosed (col. 3, lines 50-51).

Claim 63: complexes associated with starch sulfonates are disclosed (col. 5, lines 10-13).

Claims 64-65: one of the starchy materials is cereal, corn starch (col. 5, lines 53-60).

Response to Amendment

- 3) Claims 28-48, objection is withdrawn in view of cancelled claims.
- 4) Claims 46-48, rejection under 35 U.S.C. 112, first paragraph, is withdrawn in view of cancelled claims.
- 5) Claims 44-45, rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of cancelled claims.

6) Applicant's arguments filed 10/28/2003, have been fully considered but they are not persuasive.

Applicants allege that the cited prior art, Gosset, does not disclose a simultaneous introduction of a composition comprising at least one cationic starchy material and at least one sulfonated starchy material.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the concept of simultaneous introduction of a composition comprising cationic and anionic starches) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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Mark Halpern
Patent Examiner
Art Unit 1731